

III. REMARKS

Claims 23 and 26-33 are pending in this application. By this amendment, claims 23 and 29-33 have been amended herein; and, claims 24 and 25 are cancelled. Applicant does not acquiesce in the correctness of the rejections and reserve the right to present specific arguments regarding any rejected claims not specifically addressed.

Furthermore, Applicant reserves the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is requested.

Claims 23-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Claim 26 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Claims 23-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 23-33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 23-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Machin *et al.* (US Patent No. 6,877,034), hereinafter “Machin”, in view of Sanders (US Patent No. 6,411,936), hereinafter “Sanders”.

A. §112, first paragraph, Rejection of Claims 23-33

Claims 23-33 are rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the enablement requirement. Specifically, the Office asserts that the “number of metrics and solutions for a given industry is endless,” and further alleges “[t]here is nothing in the specification that clearly sets forth steps one would take to enable them to assess the impact of all possible solutions.” Office Action, page 4, item 7.

Applicant respectfully traverses the rejection and submits that the claims, as amended, clearly meet the enablement requirement. In the “Response to Arguments” section of the Office Action, the Office admits that the specification is enabling for the grocery story industry. “The specification, while being enabling for identifying and assessing solutions in the grocery story industry, does not reasonably provide enablement for every possible industry.” Office Action, page 2, item 3. Applicant has amended claims 23 and 29-33 to incorporate this, admittedly enabling, feature.

Second, Applicant also respectfully contends that one of ordinary skill in the art of, for example, business management would be enabled to practice the claimed invention, based on the specification along with his/her business management knowledge, at the time of the invention. Applicant contends that the foundation of the Office’s rejection rests, in large part, on its fallacious contention that because there are an “endless” number of possibly metrics and solution and that the specification does not disclose steps to assess impact on “all possible solutions.” Applicant respectfully contends that the Office, in making its rejection, is creating a threshold of proof that is

not only, not statutorily required, but is also erroneous because it is logically unobtainable. Simply put, to write a specification that would address each and every way (e.g., solution) to practice a feature recited in a claim, would be virtually infinite in length. It is both inherent and logical that the specification must merely provide enough information so that one of ordinary skill is able to practice the claimed invention. The Applicant has met that burden.

To this extent, Applicant respectfully submits that the claims, as amended, are clearly enabled in the specification. Accordingly, Applicant requests that the rejection be withdrawn.

B. §112, first paragraph, Rejection of Claims 26

Claim 26 is rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the enablement requirement. Specifically, the Office alleges “it is not clear what the conflict resolution rules are and it is not clear how they are implemented in such a way to determine a solution.” Office Action, page 5, item 7.

Applicant respectfully traverses the rejection and submits that the specification clearly meets the enablement requirement. Specifically, one of ordinary skill in the art of, for example, business management would be enabled to practice the claimed invention. Further, one of ordinary skill in the art would be able to obtain and/or know the conflict resolution rules for the particular industry (e.g., the grocery store industry) readily.

Applicant also traverses the rejection regarding the portion related to the Office's allegation that "it is not clear how they (i.e., conflict resolution rules) are implemented in such a way to determine a solution." Office Action, item 7, page 5. Applicant cites, for example, paragraphs [0035], [0041], and [0051] in the specification for disclosure on how to use the conflict resolution rules. As claims 23 and 26 indicate, the conflict resolution rules aid in assessing impacts of applying a set of solutions on the operational metrics for an industry when, for example, a solution has a positive impact on one metric but a negative impact on another metric.

To this extent, Applicant respectfully submits that the claimed invention is clearly enabled in the specification and/or with the knowledge of one of ordinary skill in the art of business management at the time of the invention. Accordingly, Applicant requests that the rejection be withdrawn.

C. §112, second paragraph, Rejection of Claims 23-33

Claims 23-33 are rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office asserts that the "body of the claim does not meet the objective of the claim preamble", because "it is not clear how identifying a solution to address exposed performance gaps will result in improving the business value of company." Office Action, page 5, item 9. The Office ultimately seeks clarification based on an alleged inconsistency that [w]hile some operational

metrics may affect a company's business value, there are many other factors ... that will affect the business value of a company.” Office Action, page 5, item 9.

Applicant is not aware that there is any requirement that the body of the claim meets the object of the claim preamble. However, in the interest of clarity, Applicant has amended the preamble of claim 23 to align more closely with the language in the body of the claim and with the statement made by the Office. Further regarding the preambles of claims 28-33, Applicant contends that the preambles, as currently written, are suitably in alignment with the body of the claims. Applicant respectfully contends that “generating a value proposition for a company in a specific industry” (see e.g., preambles for claims 28-33) is adequately described in the body of the claim. Accordingly, Applicant request withdrawal of the rejection.

Applicant also wishes to address the “Response to Arguments” section of the Office Action, wherein the Office states “[s]ince there are no guidelines pointing to which operational metrics are identified, if one of ordinary skill in the art identifies a metric such as employment rate [], one cannot guarantee that a solution to the employment rate will **necessarily improve the business value.**” (sic) Office Action, page 3, item 3. As stated above, the preamble to claim 23 has been amended herein to read, in part, “a solution to address exposed performance gaps of a company in a specific industry.” (see claim 23). The claims no longer necessarily seek to improve business value, but now attempt to address exposed performance gaps. As such, the claims are not indefinite.

Applicant respectfully traverses the rejection and submits that the claims are not indefinite for the following additional reasons. Specifically, even assuming *arguendo* that the Office's assertion that "other factors" may affect the business value beyond "operational metrics" is correct, the assertion is a moot point. The claimed invention speaks for itself in that the limitations within the claim (and their equivalents) are what the Applicant invented, and thereby contend will, *inter alia*, affect the business value of a company. For example, the Applicant is not contending that the identified solutions of the claimed invention are necessarily the only items that affect business value, only that the claimed invention is novel and not obvious. Further, the use of the term "comprising" in the claims indicates that there may be other limitations even within the realm of the claimed invention. That is, while *other* factors, elements, items, things, etc. outside the claims *may* also affect business value, this does not, and should not, preclude the claimed invention from being definite.

Respectfully, it appears, that the Office is contending that, in the business management environment, various macroeconomic factors will also affect the business value of a company. This can often be the case, however, this does not render the claims indefinite for one of ordinary skill in the art can discern the claimed invention.

To this extent, Applicant respectfully submits that the claimed invention is clearly enabled in the specification and/or with the knowledge of one of ordinary skill in the art of business management at the time of the invention. Accordingly, Applicant requests that the rejection be withdrawn.

D. §101 Rejection of Claims 23-33

The Office has rejected claims 23-33 for allegedly being directed to non-statutory subject matter. Specifically, the Office asserts that the claimed invention does not produce a useful, concrete, and tangible result. In making its rejection, the Office makes several statements that the Applicant will attempt to address.

First, the Office asserts that the claimed invention is not useful/lacks utility. Office Action, page 6, item 10. While Applicant concedes that claims must have utility, Applicant contends that the claims, as amended, clearly provide this requisite utility. For example, identifying a solution to address exposed performance gaps of a company in a specific industry such as the grocery store industry and outputting the solution from the computer system (see e.g., claim 23) clearly offers utility to one in the grocery store industry.

Second, the Office asserts that the claims lack concreteness because “the metrics that are set forth are directed to potential problem areas wherein the established metrics may not correlate with the problems revealed through the gap analysis.” Office Action, page 6, item 10. The Office further asserts that the claims lack concreteness because “the claims, in a sense, directed to brainstorming to come up with potential solutions to potential problems.” (sic) Office Action, page 6, item 10. Applicant respectfully contend that the claims clearly are concrete because the claims, as amended, all include, *inter alia*, outputting solutions from the computer system. This is a concrete, tangible result.

Applicant has amended independent claims to provide a more useful, concrete and tangible result. Accordingly, Applicant requests that the rejection be withdrawn.

E. §103(a) Rejection of Claims 23-33

Regarding independent claim 23, Applicant respectfully requests withdrawal of the rejection because neither Machin nor Sanders, nor the combination, teaches, or suggests, each and every feature in claim 23, (see also independent claims 29-33).

Further, the invention claimed invention is not obvious in view of Machin and Sanders.

Interpreting Machin and Sanders only for the purposes of this response, Applicant submits that, to the contrary, Machin does not teach or suggest any type of method that includes “first identifying a plurality of operational metrics for the specific industry, [], wherein the specific industry is a grocery store industry, wherein the operational metrics include at least one of a rate of inventory turnover and a number of customers per day” (emphasis added), as in claim 23 of the present invention. To the contrary, Machin merely discloses a benchmarking technique for use with a Customer Relationship Management (CRM) call center. Further, Sanders does not remedy this glaring deficiency in Machin.

In making its rejection of claim 24, the Office admits that Machine does not teach a grocery store industry. Office Action, page 9, item 12. The Office then contends that the feature is merely an intended use, and, as such, much result in a structural difference.

In reply, the Applicant contends that by incorporating the features of both claim 24 and claim 25 into claim 23 that there clearly exists a structural difference with the prior art. Clearly, *inter alia*, there are no operational metrics that are identified for a grocery store industry that includes a rate of inventory turnover. It is not even clear to Applicant what could be construed of as inventory in a conference call center in Machin.

Accordingly, Applicant submits that there is no teaching or suggestion in either Machin or Sanders of any type of a method that first identifies a plurality of operational metrics for the specific industry, wherein the specific industry is a grocery store industry, and wherein the operational metrics include at least one of a rate of inventory turnover and a number of customers per day, as disclosed in claim 23. Therefore, Applicant respectfully requests withdrawal of the rejection of claim 23.

With respect to dependent claims 26-28, Applicant herein incorporates the arguments presented above with respect to the independent claim from which the claims depend. The dependent claims are believed to be allowable based on the above arguments, as well as for their own additional features.

Further, regarding independent claims 29-33 and dependent claims 26-28 Applicant contends that for the same reasons stated above, that these claims too are allowable and, accordingly, requests withdrawal of the rejections thereto.

IV. CONCLUSION

In light of the above remarks, Applicant respectfully submits that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the number listed below.

Respectfully submitted,

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